

REMARKS

This Response is filed in reply to the Office Action dated July 11, 2003. In this Response, Applicant traverses the Examiner's rejections. Silence with regard to any of the Examiner's rejections is not an acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicant considers allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim(s), but rather a recognition by Applicant that such previously lodged rejection is moot based on Applicant's remarks and/or amendments relative to the independent claim (that Applicant considers allowable) from which the dependent claim(s) depends. Applicant reserves the option to further prosecute the same or similar claims in the instant or a subsequent application. Claims 1-20 are pending in the present application.

The issues of the July 11, 2003, Office Action are presented below with reference to the Office Action.

With regard to the Office Action, "Response to Arguments," paragraphs 1-8: Although Examiner states a consideration of the previously filed Response, many of Applicant's statements and Remarks were not addressed by the Examiner. Specifically, Examiner's failure to address all features of Applicant's claims (e.g., independent claim 16, as provided herein) and Examiner's insistence on quoting an abundance of outdated and overruled case law dating to the early 1970's, where such case law is well known throughout patent law for being so outdated and now irrelevant, causes Applicant, in the interests of expediting prosecution, to herein expressly request supervisory review of the subject Response.

In the previous Response, Applicant stated: "Examiner paraphrases In re Japikse as support for the rejection, but Examiner fails to recognize the obligations of the many recent and pertinent cases that provide the basis to establish a prima facie case of obviousness under 35 U.S.C. 103(a)." Examiner fails to address such comment, and continues to rely on such old, outdated case law. For Examiner's convenience, Applicant provides a summary of some recent case law:

As stated recently by the CAFC, In Re Sang Su Lee (January 18, 2002, 00-1158), quoting In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992), "the examiner can

Applicant's 7 lines of claim 16 is expected to be taught by the reference or about 1-5 pages. A: 1-5 pages were marked

Just because case law did doesn't mean it is invalid

satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" (emphasis provided by Applicant) Further, with regard to "hindsight:" "Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references," In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "There must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant." In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). "Teachings of references can be combined only if there is some suggestion or incentive to do so," (emphasis in original) In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988), quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984).

"Even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious," In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) "The examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references,'" In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992).

With regard to the Office Action, "Claim Rejections - 35 U.S.C. 102," paragraphs 9-10: The Examiner rejected Applicant's independent claim 15 based on 35 U.S.C. 102(b) based on Fazakerly et al. (U.S. 4,208,635).

Applicant's independent claim 15 distinctly claims both a PLL, and a detection circuit. Examiner contends on Page 3, Office Action dated March 20, 2003, to which Examiner relies for the present rejection, that the PLL is items 10, 12, and 14 of Fazakerly et al., Figure 1. Examiner also contends that the same item 10 of Fazakerly et al., Figure 1, is the distinct "detection circuit" of Applicant's independent claim 15. In the present Office Action, page 2, the Examiner states

that "the claim does not state that the clock detection circuit cannot be inside the PLL circuit."

This argument by the Examiner ignores basic rules of patent law and claim construction.

If, as the Examiner contends, Fazakerly et al.'s PLL requires elements 10, 12, and 14, then a separate item, as claimed by Applicant (e.g., "clock detection circuit"), cannot also be the same component, or Fazakerly et al.'s item 10, yet again. For example, if the "detection circuit" is removed from Applicant's claim 15, there still remains a claimed PLL, and such PLL element remains intact as a PLL as shown in Figure 1 of Applicant's disclosure. If this same modified claim (e.g., removing the detection circuit, which Examiner reads as Fazakerly et al., "phase detector 10") is applied to Fazakerly et al. and thus the phase detector element 10 is removed from Figure 1 of Fazakerly et al., then Fazakerly et al. do not have a PLL, contrary to the modified claim. One with basic skill in patent law understands that two separately claimed items are separate unless otherwise related by the claim language, and the removal of one such item allows the other to remain intact, *regardless* of whether one is "contained within" the other. This, as provided herein, is not the teaching of Fazakerly et al., and regardless of whether a PLL may be included in a detection circuit, or vice versa, Fazakerly et al.'s system (through Examiner's forced application to Applicant's claim) necessitates the integration of such PLL and phase detector components.

Those of ordinary skill understand that a PLL includes a phase detector, and thus, claiming a PLL *inherently* implies a phase detector. Separately claiming a "detection circuit," as claimed by Applicant, thus means the phase detector is a feature different from the claimed PLL and all of its inherent parts. This is basic electrical engineering, and basic patent law. It is bewildering that Examiner is confounded by these principles.

Also contrary to Examiner's contention, basic patent law principles do not require a patent applicant to expressly state that certain elements are not related, and once again, Examiner's assertions are not well founded in patent law principles.

Accordingly, if Examiner is going to apply the Fazakerly et al. system to Applicant's claim 15, Fazakerly et al.'s item 10 is either a detection circuit on its own, or it is part of the PLL, but it cannot be both. Applicant claimed the PLL *separate from* the detection circuit as such elements are *distinct*. Examiner's contention that Fazakerly et al.'s phase detector 10 can be *both* the claimed PLL *and* the claimed detection circuit is an improper rejection of Applicant's independent claim 15, for as provided herein, such elements are not the same, but

rather, in accordance with basic claim construction, distinct claim elements. Applicant thus traverses Examiner's rejection of independent claim 15 based on 35 U.S.C. 102(b), and considers independent claim 15 to be allowable.

With regard to the Office Action, paragraphs 11-18. The Examiner rejected claims 1-14 based on 35 U.S.C. 103(a) based on Bedrosian (U.S. 5,740,211). The Examiner also rejected claims 16-20 based on 35 U.S.C. 103(a) based on Richards et al. (U.S. 6,178,207).

In paragraph 10 of the March 20, 2003 Office Action, page 5, and in relation to Applicant's independent claim 1, Examiner correctly states "Bedrosian does not teach this," in referring to Applicant's claimed feedforward circuitry coupled to the clock detection circuit output, where the feedforward circuitry selectively couples at least one circuit element to the feedback filter circuit of the PLL, where the selective coupling is controlled by the clock detection circuit output. As provided in that March 20, 2003 Office Action, and as provided in the present Office Action (paragraphs 2-3), as provided previously herein, Examiner continues to espouse outdated and overruled case law such as In re Japikse as support for the rejection. Fortunately, Applicant is aware of the current obligations of a U.S. PTO Examiner practicing in the 1990's and later, and understands the Examiner's burden to establish a prima facie case of obviousness under 35 U.S.C. 103(a), and the criteria for satisfying each of the elements of such case.

In addition to the case law previously provided herein, Applicant directs the Examiner to MPEP 2143, which expressly states that a prima facie case of obviousness under 35 U.S.C. 103(a) requires (1) a suggestion or motivation in the references themselves or generally known in the art, to combine the references, (2) a reasonable expectation of success to combine, and (3) a teaching, via the combination, of all the claimed limitations. As provided previously herein through the aforementioned case law, the obligations for motivation to combine cannot be merely because the Examiner states that such is obvious. As Examiner knows, Examiner provides one reference, Bedrosian, in rejecting independent claims 1 and 14, where Examiner specifically stated that such reference did not teach all features of Applicant's independent claims 1 or 14.

Applicant further notes that because Bedrosian uses, as noted by Examiner, a configuration of components to selectively couple a feedforward and a feedback filter, a

significant alteration of Bedrosian is required to provide the feature of Applicant's independent claims 1 and 14 that includes clock detection circuit controlling a selective coupling of at least one circuit element to a feedback filter circuit *of the PLL*. The Examiner fails to provide a motivation for such redesign of Bedrosian as such motivation is required to be shown by current caselaw. Further, the Examiner fails to provide reasonable expectation of success of such design. It is clear, and admitted by Examiner as provided herein, that Bedrosian alone does not include all the elements of Applicant's independent claims 1 and 14. Accordingly, Examiner fails to provide a prima facie case of obviousness under 35 U.S.C. 103(a) for failing to provide *any* of the elements as required at least under MPEP 2143, and thus, Examiner's rejection is improper. Applicant traverses Examiner's rejection, and considers independent claims 1 and 14 to be allowable. Dependent claims 2-13 are also allowable as depending from an allowable base claim.

Independent claim 16 recites detecting a failure of a clock source, *where the clock source is coupled to an input of a phase-locked loop, and in response to said failure of said clock source*, said control signal altering a time constant within said PLL. Examiner points to Figure 12, the Digital PLL, item 12, as the PLL. Applicant directs Examiner to Column 11, lines 16-40, and Richards et al.'s Figure 12, which indicate that the input to the digital PLL, or item 1202, is "message data...in the I-Q format over input lines 1210." Richards et al.'s I-Q message data input to the PLL is *not* the same as Applicant's clock source input to a PLL.

Examiner states, Page 6 of the present Office Action, that "Richards *might not* explicitly show the clock going to the PLL. It would have been obvious to one of ordinary skill in the art ...to modify Richards to show the clock going to the PLL." (emphasis provided by Applicant) Applicant takes exception to Examiner's incorrect wording. It is not that Richards "*might not*...show," but rather, it is that Richards "does not show," which is thus the reasoning for Examiner's next statement in the quoted paragraph. Examiner then makes an argument as to why a clock input may hypothetically be desirable for an input to a PLL, incorrectly attempting to provide motivation using impermissible hindsight, and without any regard to the remaining features of Applicant's independent claim 16. For example, not only does Richards et al. not teach a clock source as an input to the PLL, but Richards et al. also do not teach Applicant's claimed "detecting a failure of the clock source [to a PLL]," and accordingly, Richards et al. also cannot teach Applicant's claimed feature of *in response to said failure of said clock source, said*

control signal altering a time constant within said PLL. Examiner fails to provide any arguments towards these other claimed features of Applicant's independent claim 16, and further, Examiner thus fails to provide a valid Office Action rejection of independent claim 16 in accordance with 37 C.F.R. 1.104(c)(2).

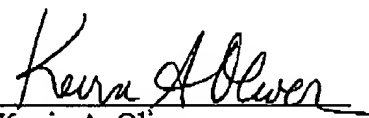
Because Richards et al. fail to teach several elements of Applicant's independent claim 16, Applicant traverses Examiner's rejection of Applicant's independent claim 16 based on 35 U.S.C. 103(a), as Examiner fails to provide a prima facie case of obviousness at least for failing to show that all features of Applicant's claim are taught by the one cited reference, but also, for failing to show a motivation to modify such reference as is required for showing motivation based on existing, current, and valid caselaw. Applicant considers independent claim 16 to be allowable. Applicant also considers dependent claims 17-20 to be allowable as depending from an allowable base claim.

Conclusion

Applicant considers the Response herein to be fully responsive to the referenced Office Action. Based on the above Remarks, it is respectfully submitted that this application is in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicant's attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at 617-832-1241.

Respectfully submitted,

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